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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,241	08/01/2003	Soo Keong Ong	42P16798	3317
8791	7590	08/09/2005	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			PATEL, NIKETA I	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,241

Applicant(s)

ONG ET AL.

Examiner

Niketa I. Patel

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 5, 9, 16, 20, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Harari et al. U.S. Patent Number: 6,266,724 B1 (hereinafter “*Harari*”).

3. **Referring to claims 1, 9, 16, 24, *Harari*** teaches a circuit, a method, a computer system and a machine-readable medium having stored thereon data representing sequences of instructions that, when executed by a processor, causes the processor to perform operations comprising: a first device that is not compliant with a standard [see figure 1, element 20 and column 6, lines 63-67 and column 7, lines 4-23], the first device containing data [see column 7, lines 62-67 and column 8, lines 1-20]; a second device that is compliant with the standard [see figure 1, element 10], the second device to be a temporary target for the data from the first device [see column 7, lines 62-67 and column 8, lines 1-20, ‘a buffer memory for buffering data between the host and the peripheral’]; and a memory to receive the data from the first device [see column 7, lines 62-67 and column 8, lines 1-20, ‘host’ and column 1, lines 15-27, ‘RAM’].

4. **Referring to claims 5, 20, *Harari*** teaches wherein the first device comprises flash memory [see column 7, lines 65-67, ‘flash memory on a daughter card’].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 8, 10-13, 17-19, 23 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al. U.S. Patent Number: 6,266,724 B1 (hereinafter "*Harari*".)

7. **Referring to claims 2, 10, 17, 25, *Harari*** teaches a device that is compliant with the standard [see figure 1, element 10] however does not set forth the limitation of further comprising a plurality of devices that are compliant with the standard.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to get the advantage of having plurality of devices that are compliant with the standard in order to provide a user with multiple devices to complete desired tasks. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include plurality of devices to get this advantage.

8. **Referring to claims 11, 26, *Harari*** teaches a device that is compliant with the standard [see figure 1, element 10] however does not set forth the limitation of wherein choosing the standard peripheral device comprises pre-selecting the standard peripheral device before commencing operations.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to get the advantage of having knowledge of a peripheral device which will be receiving data before transmitting the data to the

Art Unit: 2182

peripheral device in order to avoid transmission errors. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention pre-selecting the standard peripheral device before commencing operations to get this advantage.

9. **Referring to claims 3, 12, 18, 27**, teachings of *Harari* as modified above teaches a device that is compliant with the standard [see figure 1, element 10] however does not set forth the limitation of further comprising a controller to scan the plurality of standard devices to identify the second device.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to get the advantage of having knowledge of a peripheral device which will be receiving data before transmitting the data to the peripheral device in order to avoid transmission errors. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention scan the plurality of standard devices to identify the second device to get this advantage.

10. **Referring to claims 4, 19**, *Harari* teaches wherein the second device comprises a function of a physical device [see figure 1, element 10.]

11. **Referring to claims 8, 13, 23, 28**, *Harari* is silent regarding wherein the standard comprises a PCI (peripheral component interconnect) specification.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to get the advantage of using PCI standard since it presents an easy to implant interface that can use current chipset technologies form the host processor bus and it has good performance, industry standard protocols and

Art Unit: 2182

provisions for system boot control. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include PCI standard to get this advantage.

12. Claims 6-7, 14-15, 21-22 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al. U.S. Patent Number: 6,266,724 B1 (hereinafter "*Harari*") and further in view of Eidson et al. U.S. Patent App. Pub. No.: 2004/0098516 A1 (hereinafter "*Eidson*").

13. Referring to claims 6, 14, 21, 29, *Harari* teaches wherein the flash memory comprises data [see column 7, lines 65-67, 'flash memory on a daughter card'.] *Harari* fails to set forth the limitation of wherein the data comprises an operating system however, *Eidson* teaches this limitation [see *Eidson* figure 2, element 26 and paragraphs 17, 21, 24] because FLASH memory is reprogrammable, relatively fast and reasonably economical.

One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite advantageous for the system of *Harari* to use flash memory to store operating system because FLASH memory is reprogrammable, relatively fast and reasonably economical. It is for this reason that one of ordinary skill the art would have been motivated to use *Harari*'s flash memory to store operating system because FLASH memory is reprogrammable, relatively fast and reasonably economical.

14. Referring to claims 7, 15, 22, 30, teachings of *Harari* as modified by the teachings of *Eidson* as applied above, teaches wherein the data includes a boot loader, the boot loader being stored as an option-ROM for the first device [see *Eidson* figure 2, element 24 and paragraphs 17, 21, 24.]

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

16. Claims 24-30 are rejected under 35 U.S.C. 101 because the claim 24 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 15, paragraph 38, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., floppy diskettes, optical disks, CD-ROMs) and intangible embodiments (e.g., data signals, carrier wave and other propagation medium.) As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media (e.g. "a machine readable storage medium having".) In the specification the machine readable medium needs to be grouped into two separate categories: tangible and intangible (e.g., 1) storage media such as floppy diskettes, optical disks, CD-ROMs and 2) transmission media such as data signals, carrier wave and other propagation medium.)

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents have been made record of to further show the state of the art as it pertains to Option-ROM:

Powderly et al. U.S. Patent Number: 6,760,785 B1

Wilson et al. U.S. Pat. App. Pub. No.: 2004/0205258 A1

Art Unit: 2182

Belonoznik U.S. Pat. App. Pub. No.: 2005/0060481 A1


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niketa I. Patel whose telephone number is (571) 272 4156. The examiner can normally be reached on M-F 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272 4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NP

08/04/2005


KIM HUYNH
PRIMARY EXAMINER
8/5/05